

Appl. No. 09/937,263
Atty. Docket No. CM2094
Amdt. dated February 21, 2006
Reply to Office Action of August 18, 2005
Customer No. 27752

REMARKS

Claim Status

Claims 1, 2, 5 and 7-12 are pending in the present application. No additional claims fee is believed to be due.

Amendment to the Specification and Objection to the Drawings

The Office Action objects to the drawings as submitted, stating that the drawings must show each and every feature of the invention specified in the claims. The Specification describing previously presented Figure 2 has been amended to show how the currently detailed elements of Figure 2 describe each and every element of Applicant's claimed invention in compliance with 37 CFR § 1.121(d).

Support for the amendments to the Specification can be found in the Specification at Page 1, Line 28 to Page 2, Line 21; Page 2, Line 34 to Page 3, Line 14; Page 3, Lines 18-27; and in Claims 10 and 11 as originally filed and subsequently amended.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §103(a) Over Griffith et al. (U.S. Patent No. 5,887,176) in view of Goff et al. (U.S. Patent No. 6,600,420) and Alternatively Over Goff et al. (U.S. Patent No. 6,600,420) in view of Griffith et al. (U.S. Patent No. 5,887,176)

Claims 1, 2, 5 and 7-12 are rejected under 35 USC §103(a) as being unpatentable over Griffith et al. (U.S. Patent No. 5,887,176) in view of Goff et al. (U.S. Patent No. 6,600,420), and alternatively over Goff et al. (U.S. Patent No. 6,600,420) in view of Griffith et al. (U.S. Patent No. 5,887,176). Applicant contends that the reference combination of Griffith et al. and Goff et al. does not establish a prima facie case of obviousness, and for the reasons set forth below respectfully traverses these rejections.

In making the rejection, the Examiner asserted that Griffith et al. teaches a "system that utilizes radio frequency circuitry in combination with microprocessor devices and specifically designed software to provide an improved structure and operation for the monitoring, protection, and control of inventory assets" (Page 3,

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Paragraph 11.a.), and that Goff et al. teaches a radio frequency identification system including "antenna self tape...for use with items having radio frequency identification elements or tags associated with items of interest." (*Page 3, Paragraph 11.b.*). The Examiner acknowledged, however, that Griffith et al. differs from the presently claimed invention in that Griffith et al. does not disclose the use of multi-bit magnetic tags (*Page 4, Paragraph 11.d.*), and that Goff et al. differs from the present invention in that Goff et al. does not teach nor disclose use of an electronic character display on the product support. (*Page 4, Paragraph 11.e.*)

The office action concludes that "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the systems of Griffith et al., to incorporate the multi-bit magnetic tags taught by Goff et al., or alternatively to modify the systems of Goff et al. with the electronic character displays taught by Griffith et al. Applicant respectfully asserts this conclusion is in error.

As is fundamental, a *prima facie* case of obviousness must be based on facts, "cold hard facts." *In re Freed*, 165 USPQ 570, 571-72 (C.C.P.A. 1970). When the rejection is not supported by facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (B.P.A.I. 1993).

As is well settled, an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would *impel* one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993). The rejection fails to provide any reason why one would be motivated, let alone impelled, to combine the *Griffith et al. and Goff et al.* references in the manner suggested by the Examiner to achieve Applicant's claimed storage systems. Thus, the rejection fails to set forth the required facts and reasoning required to support a *prima facie* case of obviousness.

The rejection posits generally that one "would have been motivated to employ the systems of Griffith et al. in conjunction with Goff et al. (or alternatively the system of Goff et al. with those of Griffith et al.) with the expectation of obtaining the presently claimed storage systems. As is well settled, however, an Examiner's belief or conjecture is no substitute for statutory prior art. *In re Kratz*, 201 USPQ 71, 76 (CCPA 1979) *citing*, *In re Antonie*, 195 USPQ 6 (CCPA 1977). ("We have previously rejected the argument

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that undirected skill of one in the pertinent art is an adequate substitute for statutory prior art.”). Applicant respectfully contends that because the rejection has substituted conjecture as to what one skilled in the art would believe for the required statutory reference, the rejection should be withdrawn.

As is now well settled, obviousness *cannot* be based on the unknown. *In re Ochia*, 37 USPQ2d 1127, 1131 (Fed. Cir.1995). A *prima facie* case of obviousness requires that the rejection describe with specificity *why* one skilled in the art would have combined two references to arrive at the claimed invention. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (CAFC 1999). (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of *the requirement for a showing of the teaching or motivation to combine prior art references*.”). In the present case, no such explanation is found in the rejection.

Thus, the rejection is not supported by the kind of specificity required to sustain a conclusion of obviousness. *Ex parte Humphreys*, 24 USPQ 2d 1255, 1262 (BPAI 1992). (“The Examiner’s rejection is not specific as to how one of ordinary skill in the art would have found it (the claimed invention) obvious”). Obviousness cannot be based upon speculation, possibilities or probabilities. Obviousness *must* be based upon facts, “cold hard facts.” *In re Freed*, 165 USPQ 570, 571-72 (CCPA 1970). When a conclusion of obviousness is not based upon facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (BPAI 1993).

The Examiner has the burden of establishing (1) that there is suggestion or motivation to combine the references relied upon, and (2) that the references, when so combined, contain the requisite suggestion and motivation which would have led one to combine the particular disclosure relied upon and to make a composition as claimed. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Here, the Examiner has not provided *any* reason for *why* one would have picked the radio frequency identification system of Goff et al. and the remote inventory tracking system of Griffith et al. incorporate to achieve Applicant’s storage system as claimed.

The Examiner is required to demonstrate *where* in the Griffith et al. and Goff et al. references there is a suggestion which would have “strongly motivated” one to make

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storage systems as claimed. *Ex parte Graselli*, 231 USPQ 393, 394 (Bd. App. 1986).

The type of motivation which would have "*impelled*" one to do so (*Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993)), and the type of suggestion that the changes "*should*" be made. *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. App. 1964).

Because the Examiner has not identified *any* suggestion, reason, or other motivation, including suggestion of desirability, for *why* one would have been led to pick the radio frequency identification systems of Goff et al., and include it with the inventory monitoring systems of Griffith et al. to achieve the storage systems as claimed, the rejection should be withdrawn.

Moreover, should the Examiner provide such a showing in accordance with MPEP § 2144.03 and 37 CFR 1.104(d)(2) as has been requested, the rejection over the reference combination of Griffith et al. and Goff et al. would still be deficient because the Examiner's "obvious to use" argument employs the wrong legal standard. *In re Antonie*, 195 USPQ 6, 8 (CCPA 1977). "Obvious to use" *disregards* the invention as a whole, and "obvious to use" does *not* release the Examiner from the burden of establishing *all* of the elements required to make out a *prima facie* case of obviousness for each claim.

To establish a *Prima Facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation to modify the references or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest each and every element of the claims. *See MPEP 2143*.

It is noted that the office action relies on the Griffith et al. reference, in the reference combination of Griffith et al. and Goff et al., to teach the use of an electronic character display on the support. Applicant, however, respectfully asserts that this conclusion is in error. The Griffith et al. reference neither teaches nor suggests the use of either a support, or an electronic character displays in combination with a support. Moreover, the Goff et al. reference neither teaches nor suggests the use of electronic character displays on supports. As the reference combination of Griffith et al. and Goff et al. fail to disclose Applicant's claimed element of electronic character displays on supports, Applicant respectfully asserts therefore that a *prima facie* case of obviousness has not been established and that continued rejection is in error.

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Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC §103(a). Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 2, 5 and 7-12 is respectfully requested.

Respectfully submitted,

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By 

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